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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,152	09/24/2003	Seiji Horie	019519-406	2760
21839	7590	11/24/2006	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/668,152

Applicant(s)

HORIE ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11/6/06 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4 and 6.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' response, 1.132 declaration, and terminal disclaimer filed 11/6/06 have been considered, however, they are not persuasive.

(A) The terminal disclaimer filed on 11/6/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 10/668,158 has been reviewed and is NOT accepted for the following reason.

- a. The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34

(a). See 37 CFR 1.321(b) and/or (c).

It would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the organization.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

(B) Applicants argue that Kato et al. (U.S. 6,143,806) and Qian et al. (U.S. 2002/0128349) are not relevant references against the present claims given that neither reference discloses fine particles obtained by melting and kneading a coloring agent and a binder resin and cooling and pulverizing the resulting mixture to form a colored admixture and dispersing the colored admixture in non-aqueous solvent as required in present claim 1.

It is agreed that neither Kato et al. or Qian et al. disclose producing fine particles by melting and kneading followed by cooling and pulverizing, however, as previously argued by the examiner in paragraph 10 of the office action mailed 8/4/06, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

Therefore, absent evidence of criticality regarding the presently claimed process and given that Kato et al. and Qian et al. each meet the requirements of the claimed product, i.e. fine particle comprising coloring agent and binder resin, it is the examiner’s position that Kato et al. and Qian et al. each meet the requirements of the present claims.

In response to the above argument, applicants have submitted a 1.132 declaration to show that the fine particles obtained in the manner presently claimed are distinct from the materials employed in Kato et al. or Qian et al. Applicants argue that the data in the declaration establishes the surprising or unexpected nature of the claimed oil-based ink.

It is noted that the declaration filed 11/6/06 compares oil-based ink of the present invention comprising fine particles as presently claimed with oil-based ink of example 1 of Kato et al. and toner of example 21 of Qian et al. It is shown that the ink of the present invention is superior in terms of rub resistance.

However, it is the examiner's position that the data is not persuasive for the following reasons.

Firstly, there is not proper side-by-side comparison between the inventive ink and the comparative compositions. Given the examiner's position that the patentability of a product does not depend on its method of production and that the present claims are unpatentable over Kato et al. or Qian et al. even though the fine particles are made by a different process, the burden shifted to applicants to come forward with an unobvious difference between the claimed product and the prior art product. However, given that the fine particles of the inventive ink are made not only from a different process but also from different binder resin than the particles of the ink of Kato et al. or Qian et al., it is not clear if the difference between the inventive ink and the ink of either Kato et al. or Qian et al. is due to the type of binder resin utilized or due to the process used to form the fine particles. That is, while the declaration establishes that ink comprising binder as presently claimed is superior to ink comprising binder outside the scope of the present

claims, Kato et al. and Qian et al. already disclose the presently claimed binder resin, i.e. obtained from monofunctional monomer A containing aliphatic cyclic hydrocarbon group having 5 to 30 carbon atoms and monofunctional monomer (B) a homopolymer of which is soluble in the non-aqueous dispersion medium, and thus are each utilized against the present claims under 35 USC 102. The difference between Kato et al. or Qian et al. and the present claimed invention is that there is no disclosure in Kato et al. or Qian et al. that the fine particles are made by process as presently claimed. It would appear that in order to overcome the rejections of record, a comparison must be made between ink comprising fine particles obtained from colorant and binder as presently claimed and prepared by presently claimed process versus ink comprising fine particles obtained from the same colorant and same binder but prepared by process of Kato et al. or Qian et al.

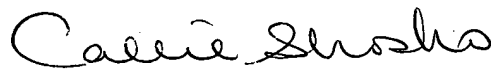
Further, it appears that the data in the declaration is not commensurate in scope with the scope of the present claims.

The present claims require fine particles being obtained by melting and kneading a coloring agent and a binder resin, and cooling and pulverizing the resulting mixture to form a colored admixture and then dispersing the colored admixture in non-aqueous medium. As the inventive example discussed in the 1.132 declaration filed 11/6/06, applicants utilize ink of example 1 of the present specification. However, while example 1 of the present specification discloses producing fine particles by melting and kneading the coloring agent and binder resin followed by pulverizing the resulting mixture to form colored admixture and dispersing the

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colored admixture in non-aqueous medium, there appears to be no disclosure of cooling step as required in present claim 1.

In light of the above, it is the examiner's position that Kato et al. and Qian et al. remain relevant references against the present claims.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
11/20/06